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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,770	09/11/2000	Frank J. McConnell	SACO115537	4422

26389 7590 08/02/2005

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EXAMINER

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ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/02/2005

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/658,770
Filing Date: September 11, 2000
Appellant(s): MCCONNELL ET AL.

D.C. Peter Chu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 February 2005.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

There is no statement of issues in the brief.

(7) Grouping of Claims

The rejection of claims 1, 3-8, 10-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Accordingly, it is the Examiner's contention that all the claims stand or fall together, and consequently Examiner's discussion and arguments will primarily focus upon the limitations of claim 1.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

1. 5, 537, 315A Mitcham 07-1996

2. CNA Customer Services website. 03-2000

URL:<http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html>.

3. MostChoice Advisor website. 08-2000

URL:<http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm>.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b).

Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Action, Paper No 17 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Action (Paper No 17). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper 17.

1. Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham, U.S. Patent Number 5, 537, 315.

(A) As per claims 1 and 3, Mitcham teaches a method for providing an insurance policy via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36, column 3, lines 30-61), comprising:

receiving a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60);

gathering underwriting information from one or more outside information resources based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determining whether said insurance policy may be underwritten (Mitcham; Figure 3G, column 8, lines 1-23);

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in response to determining that said insurance policy may be underwritten, calculating a premium for said insurance policy and providing said premium to a requestor of said premium quotation as a bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47);

receiving a request to purchase said insurance policy according to said bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 22-25); and

in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8);

wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy, or issuing the policy on-the-spot, to an individual insured by said insurance policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32).

(B) As per claim 19, Mitcham teaches a computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3 (Mitcham; see at least Figure 1 column 3, lines 30-61).

2. Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent Number 5, 537, 315 in view of CNA Customer Services State Sales Offices website, hereinafter known as CNA, URL:

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<http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html>, and further in view of MostChoice Advisor website, hereinafter known as MostChoice, URL:

<http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm>.

(A) As per claims 4-7, Mitcham teaches a method as analyzed and discussed in claim 1 above.

Mitcham fails to explicitly disclose a method wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected or assigned insurance agent; and

remitting a commission to said selected or assigned insurance agent,

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

CNA teaches a method wherein re-intermediating an insurance agent comprises:

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providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10)

transmitting information regarding said individual and said insurance policy to said selected insurance agent by fax or e-mail or phone (CNA; pages 1-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for providing an insurance policy via a distributed computing network of Mitcham to include wherein re-intermediating an insurance agent comprises providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, as taught by CNA, with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16).

Mitcham and CNA do not explicitly disclose

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

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remitting a commission to said selected or assigned insurance agent

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

MostChoice teaches

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said assigned insurance agent (MostChoice; see at least page 6); and

remitting a commission to said assigned insurance agent (MostChoice; see at least page 8)

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1-4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Mitcham and CNA to include assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer, as taught by MostChoice, with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

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(B) Claim 8 differs from claim 1 in that it is a system for providing an insurance policy via a distributed computing network rather than a method for providing an insurance policy via a distributed computing network.

As per claim 8, Mitcham, CNA and MostChoice teach a system for providing an insurance policy via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36, column 3, lines 30-61), comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network (CNA; pages 1-19), (MostChoice; pages 1-9) , and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60);

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request (Mitcham; Figure 3G, column 7, lines 54-64), (MostChoice; pages 1-5);

gather underwriting information from one or more outside information resources based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determine whether said insurance policy may be underwritten (Mitcham; Figure 3G, column 8, lines 1-23), (MostChoice; page 3);

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation (Mitcham; see at

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least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47), (CNA; pages 18-19), (MostChoice; pages 1-3, 8, 10);

receive a request to purchase said insurance policy according to said bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 22-25);

re-intermediate and insurance agent (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8); and

issue said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8).

The motivations for combining the respective teachings of Mitcham, CNA and MostChoice are as given in the rejection of claims 1 and 4 above, and incorporated herein.

(C) As per claims 10-13, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claim 8 above wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy (MostChoice; see at least pages 1-4, 6, 8, 12);

wherein said interactive help system comprises an interactive chat facility or Advisor Connect service for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative (MostChoice; see at least pages 1-4, 6, 8, 11) and

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wherein said interactive help system further comprises an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative (CNA; pages 1-10), (MostChoice; see at least pages 1-4, 6, 8, 12) and

wherein said interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance (MostChoice; see at least pages 1-4, 6, 8, 11).

(D) As per claims 14-15, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claim 8 above wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy, or issuing the policy on-the-spot, to an individual insured by said insurance policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32) and wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents (CNA; pages 1-10);

assigning said selected insurance agent to said insurance policy (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said selected insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice; see at least page 6); and

remitting a commission to said selected insurance agent (MostChoice; see at least page 8).

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(E) As per claims 16-18, Mitcham, CNA and MostChoice teach a system as discussed and analyzed in claims 8 and 14 above wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10);

assigning said selected insurance agent to said insurance policy, including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said selected or assigned insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice; see at least page 6); and

remitting a commission to said selected or assigned insurance agent (MostChoice; see at least page 8)

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1, 3, 10).

(F) As per claim 19, Mitcham, CNA and MostChoice teach a computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 4-7 (Mitcham; see at least Figure 1 column 3, lines 30-61).

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(11) Response to Argument

In the Appeal Brief filed 25 February 2005, Appellant makes the following twenty-nine arguments:

(A) Summary of the References.

1. Summary of Mitcham
2. Summary of the CAN Reference
3. Summary of the MostChoice Reference

(B) Rejection Under 35 U.S.C. 102(b) in View of the Teachings of Mitcham

1. Claims 1 and 19

- a. The Examiner Has Failed to Establish a *Prima Facie* Case of Anticipation by Neglecting to Show That Every Claim Limitation Is Taught by Mitcham
- b. To Anticipate an Invention, the Prior Art Must Teach the Identical Invention
- c. Only Through A Distortion of The Teachings of Mitcham Can the Examiner Argue Identity of Invention

2. Claim 3

(C) Rejection Under 35 U.S.C. 103(a) in View of the Teachings of Mitcham, the CAN Reference, and the MostChoice Reference

1. Claim 4

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- a. To Combine, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, and the Combination Would Destroy the Operation of All the Reference
- b. Not All Claim Limitations Have Been Taught or Suggested by the Combination of Mitcham and the CNA Reference

2. Claim 5

3. Claim 6

- a. The Examiner Has Failed to Provide Authentic Evidence of Obviousness
- b. The Examiner Cannot Use Unsubstantiated Knowledge to Supplant the Burden of Providing Trustworthy Evidence of Obviousness
- c. The Examiner Has Insisted That Somehow The MostChoice Reference Must Teach Appellants' Invention Despite Evidence To The Contrary
- d. To Combine the References, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, or the Approach of the MostChoice Reference Must Be Disposed of, and the Combination Would Destroy the Operation of All the References

4. Claim 7

5. Claim 8

6. Claim 10

7. Claim 11

8. Claim 12

9. Claim 13

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10. Claim 14

11. Claim 15

12. Claim 16

13. Claim 17

14. Claim 18

(D) A Recap of the Claimed Invention Clearly Shows That None of the Applied References Teaches, Let Alone Renders Unpatentable, the Claimed Invention

Examiner will address Appellant's arguments in sequence as they appear in the brief.

(A) Summary of the References

1. Summary of Mitcham

In response to Appellant's assertion, on page 12 of the Appeal brief, that Examiner's analysis of the Mitcham reference is incorrect because "Mitcham allows a user to independently create a binding insurance agreement ... 'without the need for interacting with a representative of an insurance company' ... See column. 4, lines 10-11," Examiner respectfully disagrees with Appellant's interpretation of the Mitcham reference. Although the text of Appellant's quotation is correct, it omits the words "a user may independently create a binding agreement, such as an insurance agreement" (emphasis added) and is taken out of context, representing only one embodiment of the Mitcham invention. In particular, Examiner notes that Mitcham teaches re-intermediating the insurance agent following the receipt of a request to purchase an insurance

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policy. Note, for example, that Mitcham teaches a system where, in one embodiment, "[t]he options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program" (Mitcham; column 6, lines 20-24) (emphasis added). Further, Mitcham teaches that it is known in the insurance industry for a representative or agent of an insurance company to create an insurance agreement or policy based on information obtained from a prospective insured and that an insurance rate is calculated based on the information the prospective insured provides, in addition to the level of coverage the individual desires (Mitcham; column 1, lines 64 to column 2, line 2) and as well, Mitcham advises, in Figure 13, that "no sales call will be made without your request. To purchase your policy, please contact [...insurance agency or agent...] at [...recited phone number...]" (emphasis added), thus teaching re-intermediating the agent upon receiving a request to purchase a policy. The Examiner interprets this to mean that Mitcham allows the purchase of a policy in either embodiment, either without or with the re-intermediation of an insurance agent.

In response to Appellant's assertion, on page 12 of the Appeal brief, that "Mitcham distinguishes between a representative of an insurance company and an independent agent... and completely lacks the process of reintermediating an independent agent..." Examiner notes that whether or not an agent is independent is not a pertinent issue, as these are not claimed limitations.

In response to Appellant's statement, at paragraph 1 of page 13 of the Appeal brief, that "[t]hus, the distinguishing difference between the system of Mitcham and the present invention is the lack of receiving a request to purchase an insurance policy according to a bindable insurance

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premium quotation, and in response to the request re-intermediating an insurance agent and issuing the insurance policy" Examiner respectfully disagrees.

Thus, Examiner respectfully reasserts that the system of Mitcham teaches these limitations of claim 1, including receiving a request for a bindable premium quotation for an insurance policy (Mitcham; Figure 4, Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 9-31, column 5, lines 1-4) and in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8). In particular, Examiner interprets Mitcham's teachings of "a user may ... create a binding agreement...such as an insurance agreement" (Mitcham; column 4, lines 9-10) and "...providing the lowest rate for a particular level of coverage..." (Mitcham; column 4, lines 18-19) and "a user may then receive a binder upon the selection of a particular level of coverage" (Mitcham; column 4, lines 22-23) as teaching "receiving a request for a bindable premium quotation for an insurance policy." In addition, Examiner interprets Mitcham's teachings of "having a representative of an insurance company contact the user" (Mitcham column 6, lines 21-23) and "to purchase your policy, please contact AUTOSURE at (214) 325-3001" (Mitcham; Figure 13, lines 32-34) and "[t]hereafter the process passes... transmission of the user's permission to contact the user...to the selected company..." (Mitcham; column 8, lines 31-36) as teaching "in response to said request, re-intermediating an insurance agent and issuing said insurance policy."

In response to Appellant's assertion, on page 13, paragraph 2 of the Appeal brief, that, as an option available to the user, "the user can elect to have a representative of an insurance

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company (not an insurance agent) contact the user," (emphasis added) Examiner respectfully notes that Appellant does not point to portions of the Mitcham reference that support the assertion that the representative of the insurance company is not an insurance agent, nor does Appellant provide reasoning in the Appeal Brief why a representative is not an agent. Furthermore, Examiner notes that as documented in the applied art, Mitcham teaches allowing the user to select the option "having a representative of an insurance company contact the user" (Mitcham column 6, lines 21-23) and reintermediating an insurance agent by stating "to purchase your policy, please contact AUTOSURE at (214) 325-3001" (Mitcham; Figure 13, lines 32-34). Examiner is giving the words "representative of an insurance company" their broadest reasonable interpretation, and understands a representative who can sell insurance to be an "insurance agent."

2. Summary of the CNA Reference

With regard to Appellant's assertion on page 14 of the Appeal brief that "no method of providing an insurance policy via a distributed computing network is taught or even suggested by the CNA reference, Examiner respectfully notes that the Appellant is applying references to limitations to which they were not applied. The CNA reference was applied to teach a method wherein re-intermediating an insurance agent comprises: providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual (CNA; pages 1-10); receiving the selection of a selected agent from the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10); transmitting information regarding said individual and said insurance policy to said selected insurance agent

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by fax or e-mail or phone (CNA; pages 1-10). Nevertheless, Examiner notes that CNA reference's teachings of sending emails to "independent agents and brokers across America" and "to locate the Web site of a CNA agent in your area" (CNA; page 13, lines 1-3) inherently includes utilizing the Internet (reads on "a distributed computing network") to sell insurance.

3. Summary of the MostChoice Reference

With regard to Appellant's taking notice in the last paragraph on page 14 of the Appeal Brief of one embodiment of the MostChoice reference, and provides a quotation which mentions the possibility of applying for insurance with only minimal advice, Examiner notes that the MostChoice reference also contains, just prior to the abovementioned quotation, the qualifying words "[y]ou can see that using a local advisor makes a lot of sense, and in fact that some of our online-only competitors are misleading you by implying that it is cheaper and easier to do it all yourself online" (MostChoice; page 1, just below table). Examiner interprets these words as negating Appellant's quotation.

With regard to Appellant's attempts on page 15, first paragraph of the Appeal brief to disparage the usefulness of an archived website because it contains one page designated as "Under Construction," Examiner notes that it was not this page that was applied to Appellant's invention. Furthermore, the MostChoice website, consisting of a plethora of linked web pages, twelve of which are used as references, appears to have been actively maintained during the period cited, and recites the claimed elements as analyzed and discussed in the prior Office Action (paper number 17). In addition, as is well known in the art, archived web pages are frequently not maintained to the present day. Many archived websites are, in fact, actively

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disabled by site owners using software known as robots. Nevertheless, the discovery by Applicant of one web page listed as "Under Construction" today neither proves nor disproves the enablement of these web pages at the time the claimed invention was made. Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches" (emphasis added). *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991)."

(B) Rejection Under 35 U.S.C. 102(b) in View of the Teachings of Mitcham

1. Claims 1 and 19

With regard to Appellant's assertion in the paragraph bridging pages 15-16 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claims 1 and 19, these features have been discussed in previous sections responding to Appellant's section (A)1. arguments of this Examiner's Answer, and incorporated herein.

a. The Examiner Has Failed to Establish a *Prima Facie* Case of Anticipation by Neglecting to Show That Every Claim Limitation Is Taught by Mitcham

With regard to Appellant's assertion on pages 16-17 of the Appeal Brief that the Mitcham reference fails to teach or suggest at least two claim limitations, Examiner respectfully disagrees.

With regard to the first claim limitation that Appellant asserts is not taught by the Mitcham reference, Examiner interprets the claimed limitations of "receiving a request for a bindable premium quotation for an insurance policy" as being taught by Mitcham's teachings of "a user may ... create a binding agreement...such as an insurance agreement" (Mitcham; column 4, lines 9-10) and "...providing the lowest rate for a particular level of coverage..." (Mitcham; column 4, lines 18-19) and "a user may then receive a binder upon the selection of a particular level of coverage" (Mitcham; column 4, lines 22-23). In addition, Examiner interprets the claimed limitations of "in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as being taught by Mitcham's teachings of "having a representative of an insurance company contact the user [... in response to a request ...]" (Mitcham column 6, lines 21-23) and "to purchase your policy, please contact AUTOSURE at (214) 325-3001" (Mitcham; Figure 13, lines 32-34) and "[t]hereafter the process passes... transmission of the user's permission to contact the user...to the selected company..." (Mitcham; column 8, lines 31-36).

With regard to the second claim limitation that Appellant asserts is not taught by the Mitcham reference at paragraph 2 on page 17 of the Appeal Brief, Examiner understands a bindable insurance premium quotation to be as defined in Appellant's specification on page 7, lines 3-5, i.e. "a quotation of a premium for an insurance policy that may be purchased immediately by the customer." Examiner interprets the claimed limitations of "a bindable premium quotation for an insurance policy" as being taught by Mitcham's teachings of "a user may ... create a binding agreement...such as an insurance agreement" (emphasis added) (Mitcham; column 4, lines 9-10). Furthermore, Examiner interprets the teachings of a published

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document (as shown in Mitcham's Figure 13) offering an "informational quotation" which contains the words "Rates quoted are valid for 15 days from above date" and "Quote Number: [number]" (Mitcham; Figure 13, line 3 on top right side) and also offering notification that "[c]hanges in coverage will affect this proposal and premium amounts quoted" (Mitcham; Figure 13, lines 32-34) and further including instructions on how to purchase the policy by phoning (reads on re-intermediating) an agent, as teaching "a bindable premium quotation for an insurance policy." As such, the bindable quotation has not yet been purchased but it may be purchased, as noted in the cited lines described above, and displayed in Figure 13 of Mitcham. In the case of Mitcham, it is Examiner's interpretation that if Mitcham were publishing rates that were not purchasable or bindable (and which included the advice "[c]hanges in coverage will affect this proposal and premium amounts quoted") then the information published in Figure 13 would represent a fraudulent offering. Therefore it is Examiner's interpretation that Mitcham does provide a bindable insurance quotation, as defined in Appellant's own specification, in that Mitcham's insurance quotation is one that appears to be capable of binding the insurance company to the quotation.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly Examiner disagrees with Appellant's contention to the contrary and asserts that a *prima facie* case of anticipation has indeed been established.

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b. To Anticipate an Invention, the Prior Art Must Teach the Identical Invention

With regard to Appellant's assertion at paragraph 2 on page 18 of the Appeal Brief that the Mitcham reference fails to teach or suggest the recited "reintermediating" limitations of claims 1 and 19, these features have been discussed in previous sections responding to Appellant's section (A)1. arguments of this Examiner's Answer, and incorporated herein.

With regard to Appellant's assertions at pages 18-20 of the Appeal Brief and Appellant's citing of MPEP § 2131.01 and reference to the quotation cited in *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989): "The identical invention must be shown in as complete detail as is contained in the ... claim, (emphasis added)," Examiner notes that MPEP § 2131 states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" (emphasis added) and that "[a] claim is anticipated only if each and every element as set forth in the claim (emphasis added) is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." With this noted, Examiner points out that each and every element as set forth in the claim has been found in the Mitcham reference.

Furthermore, MPEP § 2131 additionally states, "[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)." With this noted,

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Examiner points out that the arrangement of the elements as set forth in the claims has been found in the Mitcham reference.

With regard to Appellant's allegation at paragraph 3 of page 19 of the Appeal brief that "[t]he Examiner has intimated that the Mitcham reference need not teach every element of the claimed invention, arranged as in the claims" and "[t]he Examiner has intimated that the Mitcham reference need not disclose the identical invention," Examiner respectfully notes that there have been no such intimations, and requests Appellant to provide documentation for these allegations.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the passages mentioned previously in this Examiner's Answer. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly Examiner disagrees with Appellant's contention to the contrary and asserts that a *prima facie* case of anticipation has indeed been established.

c. Only Through A Distortion of The Teachings of Mitcham Can the Examiner Argue Identity of Invention

In response to Appellant's assertion that Examiner's analysis of the Mitcham reference is incorrect, Examiner respectfully disagrees with Appellant's interpretation of the Mitcham

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reference. In the paragraphs bridging pages 20-21 of the Appeal Brief, Appellant asserts, “Mitcham provides no way of reintermediating an insurance agent in response to a request to purchase an insurance policy based on a bindable premium quotation.” Examiner respectfully disagrees and notes that the words “[t]o purchase your policy, please contact [...insurance agency or agent...] at [...recited phone number...]” (Mitcham; Figure 13, line 34) teach re-intermediating an insurance agent in response to a request to purchase a policy based upon a bindable premium quotation.

With regard to Appellant's assertion in the paragraphs bridging pages 20-21 of the Appeal Brief that “Mitcham’s option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from the continuation terminal H” Examiner notes that Mitcham teaches the option to contact an agent in Figure 13, as discussed above and as well in block 248 (see Figure 3C), in which “Display Options” includes displaying the option to have an agent contact the user, also as discussed above, and as described in Mitcham, column 6, lines 21-23.

With regard to Appellant's discussion at paragraph 2 on page 21 of the Appeal Brief of Examiner’s arguments in “the Examiner’s Final Office Action” but providing supporting references to “page 15 of the Examiner’s Answer,” Examiner requests clarification as to which document Appellant is referring, the Final Office Action (paper number 17) or the first Examiner’s Answer (paper number 12).

With regard to Appellant's assertion at paragraph 2 on page 21 of the Appeal Brief that “Examiner’s argument simply ignores Figure 3G ...” Examiner notes that in the flow charts

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provided in the Mitcham reference, the flow chart of Figure 3G is entered if the option chosen in Figure 3D is the "YES" option, that is, if the response to Block 250 ("DOES USER SELECT 'COMPLETE CONTRACT'") IS "YES." Choosing the YES option moves the action to "D," (i.e. to Figure 3E) and from there to "F," (i.e. to Figure 3G). This path is NOT a path taken if the option chosen in Figure 3D is the "NO" option, that is, if the response to Block 250 ("DOES USER SELECT 'COMPLETE CONTRACT'") IS "NO." Thus Figure 3G adds information to the flow of activity that is one possible outcome only. Furthermore, Mitcham describes this segment of the flow chart as follows:

"Block 318 illustrates a determination of whether or not the user has selected the "contact" option. If a determination is made that the user has not selected the "contact option" the process passes to block 320. Referring again to block 318 if a determination is made that the user has selected the "contact option", the process passes to block 322 which depicts the entering of the user's name, address and telephone number by the user. Thereafter the process passes to block 324 which illustrates the transmission of the user's permission to contact the user to the selected company via modem 22, United States Postal Service, or any other acceptable means" (emphasis added). (Mitcham; column 8, lines 24-35)

Examiner notes that the option to contact an or reintermediate an agent also occurs between steps 248 and 249(between Figure 3C and Figure 3D), as revealed by Mitcham's teaching of "[n]ext, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program" (emphasis added) (Mitcham; column 6, lines 19-24).

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With regard to Appellant's discussion at the first full paragraph on page 22 of the Appeal Brief as to whether or not Mitcham "forces the user to select a single choice but not two choices at once," Examiner notes that displaying varying options does not preclude selecting more than one option and that the flow chart in Figure 3D does illustrate both going to contract without an agent (if the answer to block 250 is "YES") and also reintermediating an agent, if the answer to block 250 is "NO" and the answer to block 318 is "YES." Examiner respectfully notes that Appellant's deliberations that, "as asserted by the Examiner ... a user could also choose to complete an insurance contract at the exact same time the user exits the program" represent circular reasoning as well as misreading of the Mitcham reference.

With regard to Appellant's discussion at the paragraph bridging pages 22-23 that "Figures 3E-3G reveal that the insurance contract is completed without re-intermediating..." Examiner respectfully notes that this path is NOT a path taken if the option chosen in Figure 3D is the "NO" option, that is, if the response to Block 250 ("DOES USER SELECT 'COMPLETE CONTRACT'") IS "NO." Thus Figures 3E-3G add information to the flow of activity that represent one possible outcome only, as discussed earlier in this section, and incorporated herein.

With regard to Appellant's discussion at pages 22-24 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claims 1 and 19, these features have been discussed in previous sections responding to Appellant's section (A)1. arguments of this Examiner's Answer, and incorporated herein.

As a supplementary note to Appellant's discussions of Mitcham's flow charts, Examiner observes that in Figure 3D of the Mitcham reference, Block 318 erroneously states "DOES THE

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USER SELECT “CONTRACT, ” (emphasis added), however Mitcham’s text repeatedly refers to this block as illustrating “a determination of whether or not the user has selected the “contact” option” (Mitcham; column 8, lines 24-25+).

2. Claim 3

As per Appellant’s discussion regarding claim 3 at pages 24-25 of the Appeal brief and of the limitation of “transmitting an electronic version of said insurance policy” and further regarding Appellant’s discussion of “Examiner’s understanding of the claim,” Examiner notes that Applicant appears to rely upon only a small subset of Examiner’s applied art. Further it is the entire applied reference, and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

Examiner further notes that in order for Mitcham’s invention to issue a policy from a kiosk that is remote from the insurance company and to issue it “on-the-spot” (Mitcham; Figure 4) it is inherent to Mitcham’s invention that transmission of the policy electronically must occur. However, since the precise word “transmission” fails to occur in Figure 4, Examiner respectfully directs Appellant’s attention to Mitcham’s explicit recitation of “transmitting the insurance policy via the communication means...” (Mitcham; column 10, lines 33-34).

(C) Rejection Under 35 U.S.C. 103(a) in View of the Teachings of Mitcham, the CAN Reference, and the MostChoice Reference

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1. Claim 4

With regard to Appellant's discussion at pages 24-25 of the Appeal brief that the CNA reference fails to disclose the limitations "assigning said selected insurance agent to said insurance policy," as recited in claim 4, Examiner agrees with Appellant's argument, however Examiner respectfully directs the Board's attention to the fact that it was the MostChoice reference, and not the CNA reference, that was applied to teach these limitations.

a. To Combine, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, and the Combination Would Destroy the Operation of All the Reference

With regard to Appellant's discussion at page 26 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claims 1 and 19, and also of claim 4, these features have been discussed in previous sections responding to Appellant's section (A)1. and section (C)1. arguments of this Examiner's Answer, and incorporated herein.

Furthermore, Appellant analyzes the applied references separately and argues each of the references individually. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of

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the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mitcham's method and system for providing an insurance policy via a distributed computing network (Mitcham; column 3, line 62 to column 4, line 3) in which the insurance agent or representative is re-intermediated following the receipt of a request to purchase an insurance policy (Mitcham; Figure 13, column 1, lines 64 to column 2, line 2, column 6, lines 20-24) to include the CNA reference, which includes providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, (CNA; pages 1-10) with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16), and to modify the collective teachings of Mitcham and CNA to include the MostChoice reference, which includes assigning said selected insurance agent to said insurance

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policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; pages 1-12) with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and

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(iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Appellant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

b. Not All Claim Limitations Have Been Taught or Suggested by the
Combination of Mitcham and the CNA Reference

With regard to Appellant's discussion at paragraph 1 of page 27 of the Appeal brief that the CNA reference fails to teach or suggest the limitations of "assigning said selected insurance

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agent to said insurance policy,” as recited in claim 4, and that “[a]ccordingly the Examiner has not established a *prima facie* case of obviousness,” these features have been discussed in previous sections responding to Appellant's section (C) 1. and section (C) 1. a. arguments of this Examiner's Answer, and moreover, Examiner respectfully directs the Board's attention to the fact that it was the MostChoice reference, and not the CNA reference, that was applied to teach these limitations and incorporated herein.

2. Claim 5

With regard to Appellant's discussion at paragraph 2 of page 27 of the Appeal brief that the CNA reference fails to teach the “providing...,” “receiving...,” and “transmitting ...,” limitations recited in claim 5, Examiner respectfully disagrees. The CNA reference provides a website that provides a list of available agents, including the fax, email and phone of each agent (CNA; pages 1-10), thus teaching “providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual” and “receiving the selection of a selected agent from the list of available insurance agents [i.e. by fax or e-mail or phone]” and “transmitting information regarding said individual and said insurance policy to said selected insurance agent [i.e. by fax or e-mail or phone].”

With regard to Appellant's discussion at the paragraph bridging pages 27-28 of the Appeal brief that the CNA reference fails to disclose the limitations “assigning said selected insurance agent to said insurance policy,” as recited in claim 5, Examiner notes that these features have been discussed in previous sections responding to Appellant's section (C) 1. arguments of this Examiner's Answer, and in addition, Examiner respectfully directs the Board's

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attention to the fact that it was the MostChoice reference, and not the CNA reference, that was applied to teach “assigning said selected insurance agent to said insurance policy.”

3: Claim 6

With regard to Appellant’s discussion at pages 28-29 of the Appeal brief that the MostChoice reference fails to disclose the limitation “assigning said selected insurance agent to said insurance policy,” as recited in claim 6, Examiner respectfully disagrees. Examiner interprets “[o]ur goal is to educate and empower you, then connect you with a certified local advisor...” (MostChoice, page 1, line 2) and “[w]e select only the highest quality advisors to help you” (MostChoice, page 3, line 2) who are “close by when you need them” (MostChoice, page 1, column 1, line 18) and “[w]e steer people in your area to you” (MostChoice; page 6, line 7) as teaching the argued limitations.

a. The Examiner Has Failed to Provide Authentic Evidence of Obviousness

In response to Appellant’s allegations at page 29 of the Appeal brief that the reference cited from an archived website is not authentic because “Appellants have no idea who prepared the Web documents received from the Examiner and whether the Web documents have been changed from the original. It is unclear whether the dates on these documents are publication dates. Appellants have only the Examiner to corroborate their authenticity...” Examiner respectfully disagrees.

Firstly, in response to the use of Internet web pages as prior art references, the MPEP addresses Internet searching in section 904.02(c). Additionally, the USPTO published a Patent

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Internet Usage Policy to establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the USPTO. See *Internet Usage Policy*, 64 F.R. 33056 (June 21, 1999). Also see MPEP § 707.05(e) for information pertaining to the citation of electronic documents. Furthermore, MPEP section 901.06 discusses Nonpatent Publications, stating "All printed publications may be used as references, the date to be cited being the publication date. See MPEP § 2128 - § 2128.02."

With regard to the archive site used to retrieve the prior art references, Examiner notes that this site is described in the document "About the Internet Archive," located at the URL: <<http://www.archive.org/about/about.php?PHPSESSID=65273f765ad2230e0decceb9ea80b44>>, which includes the following paragraph:

About the Internet Archive

"The Internet Archive is a 501(c)(3) non-profit that was founded to build an 'Internet library,' with the purpose of offering permanent access for researchers, historians, and scholars to historical collections that exist in digital format. Founded in 1996 and located in the Presidio of San Francisco, the Archive has been receiving data donations from Alexa Internet and others. In late 1999, the organization started to grow to include more well-rounded collections. Now the Internet Archive includes texts, audio, moving images, and software as well as archived web pages in our collections."

Also included on the site are the following paragraphs:

"The Internet Archive is working to prevent the Internet — a new medium with major historical significance — and other "born-digital" materials from disappearing into the past. Collaborating with institutions including the Library of Congress and the Smithsonian, we are working to preserve a record for generations to come.

Open and free access to literature and other writings has long been considered essential to education and to the maintenance of an open society. Public and philanthropic enterprises have supported it through the ages.

The Internet Archive is opening its collections to researchers, historians, and scholars. The Archive has no vested interest in the discoveries of the users of its collections, nor is it a grant-making organization."

Furthermore, an explanation of the embedded dates at the archive site can be found at the "frequently asked questions" page for the archive site, URL:

<<http://www.archive.org/about/faqs.php?PHPSESSID=361cbbf524ed9f5cfc7410de5e03cf49>>, which includes the following paragraph:

"Pay attention to the date code embedded in the archived url. This is the list of numbers in the middle; it translates as yyymmddhhmmss. For example in this url <http://web.archive.org/web/20000229123340/http://www.yahoo.com/> the date the site was crawled was Feb 29, 2000 at 12:33 and 40 seconds."

In the instant case, the applied nonpatent publication contains not only the web address from which it was retrieved, (which contains within it the date that the page appeared on the archived Internet website), but the copyright date printed by the publisher at the bottom of the applied pages. The Examiner accepts the copyright dates printed by the publisher at the bottom of the applied pages as being valid publication dates, and considers these dates to be "authentic."

Lastly, Examiner respectfully notes that Appellant should be able to enter the URL that has been provided by Examiner in each and every Office Action in order for Appellant to verify the authenticity of the MostChoice reference.

b. The Examiner Cannot Use Unsubstantiated Knowledge to Supplant the Burden of Providing Trustworthy Evidence of Obviousness

With regard to Appellant's contention at pages 30-31 of the Appeal brief that Examiner's statement that the MostChoice reference was "actively maintained" amounts to supernatural powers, these words from paper number 8, are reproduced below:

"The MostChoice website, consisting of a plethora of linked web pages, 12 of which are used as references, was actively maintained during the period cited, and recites the claimed elements as analyzed and discussed in the prior Office Action (paper number 5) and in the current Office Action. As is well known in the art, archived web pages are frequently not maintained to the present day. Many archived websites are, in fact, actively disabled by site owners using software known as robots. Nevertheless, the discovery by Applicant of one web page listed as "Under Construction" today neither proves nor disproves the enablement of these web pages at the time the claimed invention was made. Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991)."

In response to Appellant's allegations at paragraph 1 of page 30 of the Appeal brief that "[i]t is unclear to Appellants how the Examiner is able to divine that the web site cited in the MostChoice reference was 'actively maintained,'" Examiner interprets a website that contains many detailed and hyperlinked pages as being actively maintained. In further response, Examiner has provided the listing from the archive.org site of all the pages from MostChoice.com that are currently archived by the archive site.

As regards Appellant's discussion at paragraph 2 of page 31 of the Appeal brief of the citation from *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) discussed above and of non-enabling references, Appellant agrees with this citation by stating "[i]n Appellant's view a reference that lacks enabling disclosure 'may qualify

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as a prior art reference under 35 U.S.C. 103, but only for what is disclosed in it.’ The MostChoice reference cannot qualify as prior art for what is hidden in an “under Construction” Web page.” Examiner respectfully notes that the MostChoice reference that was applied as prior art, whether Appellant considers it to be enabling or non-enabling, was only used as prior art by Examiner for what was disclosed in it. Furthermore, Examiner also notes that the “Under Construction” page found and discussed by Appellant was not applied as a prior art reference by Examiner.

c. The Examiner Has Insisted That Somehow The MostChoice Reference Must Teach Appellants' Invention Despite Evidence To The Contrary

With regard to Appellant’s discussion at pages 31-32 of the Appeal brief that the MostChoice reference fails to disclose the limitation “assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual,” and “transmitting information regarding said individual and said insurance policy to said assigned insurance agent” as recited in claim 6, Examiner respectfully disagrees. Examiner interprets “[o]ur goal is to educate and empower you, then connect you with a certified local advisor...” (MostChoice, page 1, line 2) and “[w]e select only the highest quality advisors to help you” (MostChoice, page 3, line 2) who are “close by when you need them” (MostChoice, page 1, column 1, line 18) and “[w]e steer people in your area to you” (MostChoice; page 6, line 7) and “You will never be without an application again. We keep them in PDF format right on the site. Click here for more information;” (reads on “transmitting information regarding said individual”) (MostChoice; page 6, line 27) and “[o]ur custom software allows you to ...

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communicate with us (reads on transmitting to said insurance agent) effortlessly in real time” (MostChoice; page 6, lines 30-31) as teaching the argued limitations.

With regard to Appellant’s discussion at paragraph 1 and 2 of page 32 of the Appeal brief that the MostChoice reference fails to teach or suggest the limitations of claims 1 and 19, Examiner notes that this reference was not applied against these claims and that these features have been discussed in previous sections responding to Appellant's section (A)1. arguments of this Examiner's Answer, and incorporated herein.

- d. To Combine the References, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, or the Approach of the MostChoice Reference Must Be Disposed of, and the Combination Would Destroy the Operation of All the References

At pages 32-33 of the Appeal Brief, Appellant analyzes the applied references separately and argues each of the references individually. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mitcham's method and system for providing an insurance policy via a distributed computing network (Mitcham; column 3, line 62 to column 4, line 3) in which the insurance agent or representative is re-intermediated following the receipt of a request to purchase an insurance policy (Mitcham; Figure 13, column 1, lines 64 to column 2, line 2, column 6, lines 20-24) to include the CNA reference, which includes providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, (CNA; pages 1-10) with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16), and to modify the collective teachings of Mitcham and CNA to include the MostChoice reference, which includes assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer

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(MostChoice; pages 1-12) with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (iv) obvious does not require absolute predictability;
- (v) non-preferred embodiments of prior art must also be considered; and
- (vi) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Appellant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Accordingly Examiner disagrees with Appellant's contention to the contrary and asserts that a *prima facie* case of obviousness has indeed been established.

4. Claim 7

With regard to Appellant's discussion at page 34 of the Appeal brief that the MostChoice reference fails to disclose the limitation "wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer," as recited in claim 7, Examiner respectfully disagrees. Examiner interprets "[o]ur goal is to educate and empower you, then connect you with a certified local advisor..." (emphasis added) (MostChoice, page 1, line 2) and "[w]e select only the highest quality advisors to help you" (MostChoice, page 3, line 2) who are "close by when you need them" (emphasis added) (MostChoice, page 1, column 1, line 18) and "[w]e steer people in your area to you" (emphasis added) (MostChoice; page 6, line 7) as teaching the argued limitations.

Examiner further notes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Mitcham and CNA to include wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer, as taught by MostChoice, with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, are always available to answer questions, and can help customers get what they want without any pressure, to not let customers "fall through the cracks," and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

5. Claim 8

As per Appellant's discussion regarding claim 8 at pages 34-35 of the Appeal brief and argument that none of the applied references, either alone or in combination, teach the recited

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features of claim 8, Examiner respectfully disagrees. Although Examiner agrees with Appellant that "the kiosk of Mitcham is not a server," Examiner interprets Mitcham's recitation of "enabling a user to purchase an insurance policy and an insurance binder from a kiosk having a data entry means ... [and]...communications means connected to a remote data processing system" (Mitcham; column 9, lines 20-23) as teaching the argued limitations. Furthermore, Examiner notes that in order for Mitcham's invention to issue a policy from a kiosk that is remote from the insurance company and to issue it "on-the-spot" (Mitcham; Figure 4) it is inherent to Mitcham's invention that the kiosk connect to a remote data processing server.

6. Claim 10

As per Appellant's discussion regarding claim 10 at pages 35-36 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teach the recited features of claim 10, Examiner respectfully disagrees. Examiner interprets MostChoice's recitations of "Click here for more information" and "Click here for an example" and "[f]urther, we have tools and information on the site to assist you... Click here for details," as teaching a Web site that is operative to "provide an interactive help system to a requestor of said insurance policy" (MostChoice; page 6).

7. Claim 11

As per Appellant's discussion regarding claim 11 at page 36 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teach the recited features of claim 11, Examiner respectfully disagrees. Examiner interprets MostChoice's Advisor Connect service (MostChoice; page 1, small table at bottom of page) and "...communicate with

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us effortlessly in real time..." (MostChoice; page 6, line 30) as teaching "wherein said interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative."

8. Claim 12

As per Appellant's discussion regarding claim 12 at pages 36-37 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited features of claim 12, Examiner respectfully disagrees. Examiner interprets CNA's recitation of "[s]end an email to Brad Dillon" (CNA; page 1) as teaching "an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative."

9. Claim 13

As per Appellant's discussion regarding claim 13 at page 37 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited features of claim 13, Examiner respectfully disagrees. Examiner interprets MostChoice's recitation of "[c]lick here, we'll call you back!" (MostChoice; page 1, small table at bottom of page) as teaching "a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance."

10. Claim 14

As per Appellant's discussion regarding claim 14 at page 37 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited features of claim 14, Examiner respectfully disagrees. Examiner notes that in order for

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Mitcham's invention to issue a policy from a kiosk that is remote from the insurance company and to issue it "on-the-spot" (Mitcham; Figure 4) it is inherent to Mitcham's invention that transmission of the policy electronically must occur. However, since the precise word "transmission" fails to occur in Figure 4, Examiner respectfully directs Appellant's attention to Mitcham's explicit recitation of "transmitting the insurance policy via the communication means..." (Mitcham; column 10, lines 33-34), which Examiner interprets as teaching "transmitting an electronic version of said insurance policy to an individual insured by said insurance policy".

Further, Examiner notes that the steps recited in system claim 14 fail to provide additional structural elements to the claimed system.

11. Claim 15

With regard to Appellant's assertion on page 38 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claim 15, the recited features of "reintermediating," "providing," "receiving," "assigning," and "transmitting" have been discussed in previous sections responding to Appellant's arguments of this Examiner's Answer, and incorporated herein.

As per Appellant's assertion that none of the applied references, either alone or in combination, teaches "remitting a commission to said assigned insurance agent," Examiner respectfully disagrees. Examiner interprets MostChoice's recitation of "[w]e pay the best agent commissions possible" (MostChoice; page 6, line 9) as teaching the argued limitation.

Further, Examiner notes that the steps recited in system claim 15 fail to provide additional structural elements to the claimed system.

12. Claim 16

As per Appellant's discussion regarding claim 16 at pages 38-39 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited features of claim 16, Examiner respectfully disagrees. Examiner interprets "[o]ur goal is to educate and empower you, then connect you with a certified local advisor..." (MostChoice, page 1, line 2) and "[w]e select only the highest quality advisors to help you" (MostChoice, page 3, line 2) who are "close by when you need them" (MostChoice, page 1, column 1, line 18) and "[w]e steer people in your area to you" (MostChoice, page 6, line 7) as teaching the argued limitations.

Further, Examiner notes that the steps recited in system claim 16 fail to provide additional structural elements to the claimed system.

13. Claim 17

With regard to Appellant's assertion on page 39 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claim 17, these features have been discussed in previous sections responding to Appellant's arguments of this Examiner's Answer, and incorporated herein.

Further, Examiner notes that the steps recited in system claim 17 fail to provide additional structural elements to the claimed system.

14. Claim 18

As per Appellant's discussion regarding claim 18 at page 39 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited

features of claim 18, Examiner respectfully disagrees. Examiner interprets “[o]ur goal is to educate and empower you, then connect you with a certified local advisor...” (MostChoice, page 1, line 2) and “[w]e select only the highest quality advisors to help you” (MostChoice, page 3, line 2) who are “close by when you need them” (MostChoice, page 1, column 1, line 18) and “[w]e steer people in your area to you” (MostChoice, page 6, line 7) as teaching the argued limitations.

(D) A Recap of the Claimed Invention Clearly Shows That None of the Applied References Teaches, Let Alone Renders Unpatentable, the Claimed Invention

As per Appellant’s arguments at pages 40–41 of the Appeal brief summarizing the previously stated assertions that none of the applied references, either alone or in combination, teach the features of the claimed invention, these features have been discussed in previous sections responding to Appellant's section arguments of this Examiner's Answer, and incorporated herein.

As per Appellant’s discussion regarding claim 19 at page 41 of the Appeal brief and assertion that none of the applied references, either alone or in combination, teaches the recited features of claim 19, Examiner respectfully disagrees. Claim 19 recites, in the preamble, “a computer-readable medium containing computer-executable instructions.” Examiner interprets Mitcham's recitation of “a data processing system 10 such as an interactive multimedia kiosk 12 which may be utilized to implement the method and system of the present invention. Kiosk 12 includes a computer 14, touchscreen 16, a pointing device 18, a printer 20, modem 22, a credit card entry system 24, a data storage system 26, and a keyboard 27... a number of other

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peripherals may also be provided such as speakers and a CD-ROM device.... Computer 14 may be any suitably configured personal computer," (Mitcham; column 3, lines 31-41) as teaching these limitations.

As per Appellant's arguments at page 41 of the Appeal brief asserting that none of the applied references, either alone or in combination, teach the "subject matter of the system recited in claim 8 and the method recited in claim 1," these features have been discussed in previous sections responding to Appellant's section arguments of this Examiner's Answer, and incorporated herein.

Conclusion

Appellant's arguments at pages 12-42 of the Appeal brief submitted 25 February 2005 do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (paper number 17), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

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Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Art Unit 3626

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May 16, 2005


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